# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/943,892 | 08/29/2001 | Eric D. Anderson | 500247.03 | 2384 |

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| 7590       08/26/2004 | EXAMINER |
| Mark W. Roberts, Esq.<br>DORSEY & WHITNEY LLP<br>Suite 3400<br>1420 Fifth Avenue<br>Seattle, WA 98101 | ENGLAND, DAVID E |

| ART UNIT | PAPER NUMBER |
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| 2143 | |

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *07 June 2004*.

2a)☐ This action is **FINAL**.    2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *30-36* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 August 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

## DETAILED ACTION

1.  Claims 30 – 36 are presented for examination.

### *Double Patenting*

1.      The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees.  See *In re Goodman,* 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi,* 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum,* 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA
1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application.  See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer.  A terminal disclaimer signed by the assignee must fully comply with 37
CFR 3.73(b).

2.      Claim 30 is provisionally rejected under the judicially created doctrine of obviousness-

type double patenting as being unpatentable over claims 11-29 and 37-44 of copending

Application No. 09/943894.  Although the conflicting claims are not identical, they are not

patentably distinct from each other because of Applicant's <u>continued amendments to the claims</u>

more specifically an "Email communication program", "notification from the server to a

recipient" and "<u>if</u> the Email communication is designated for the plurality of recipients".  These

continued amendments are drawing the two application in becoming identical as opposed to their

originally presented limitations.

        This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

3.      Claim 30 is rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claims 11, 23, 37, 41 and 44 of U.S. Application No.

09/943894.


4.      Referencing claim 30, as closely interpreted by the Examiner, Applicant's copending

application 09/943894 teaches a computer-implemented method for one of a plurality of

designated recipients of an Email communication to receive the Email, comprising:

5.      providing an Email communication program on a server that is configured with

instructions to store a single copy of the Email communication on the server if the Email

communication is designated for the plurality of recipients;

6.      receiving on a recipient's computer an Email communication notification from the server

that references the single copy of the Email communication, the Email communication

notification distinct from the Email communication;

7.      requesting from the server the referenced Email communication, the request being sent to

the Email communication program from the recipient's computer system;

8.      receiving by the recipient's computer system from the server, a copy of the requested

Email communication.


## Second Office Action

9.      Claims 30 – 36 are presented for further examination.

### *Claim Objections*

10.     Claim 33 is objected to because of the following informalities:  The section of, "Email communication <u>form</u> the server," is believed to be "from".  Appropriate correction is required.

### *Drawings*

11.     The drawings are objected to under 37 CFR 1.83(a).  The drawings must show every feature of the invention specified in the claims.  Therefore, the **"if** the Email communication is designated for the plurality of recipients" must be shown or the feature(s) canceled from the claim(s).  No new matter should be entered.

12.     The drawings are objected to under 37 CFR 1.83(a).  The drawings must show every feature of the invention specified in the claims.  Therefore, the **"deleting** the stored Email communication **notification by the Email communication program**" must be shown or the feature(s) canceled from the claim(s).  No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application.  Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended."  If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.  Additional

replacement sheets may be necessary to show the renumbering of the remaining figures. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR

1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

by the examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

13.     The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

14.     Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention. This limitation of, "**if** the Email

communication notification distinct from the Email communication," is not found in the

specification. In fact, the specification suggest that at least one recipient can have the Email

communication stored on a server and has no bearing on "if" there are a "plurality of recipients",

(e.g. page 5, lines 10 – 16, *"In particular, the Message Distribution Server (MDS) system*

*receives electronic messages to be <u>distributed to one or more recipients</u>, centrally stores a single*

*copy of the message as well as various information about sending the message ... "*).

15.    Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement.  The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention.  This limitation of, "after the

indicating to the Email communication program to delete the Email communication, **deleting** the

stored Email communication **notification by the Email communication program**, even if all

recipients have not indicated to the Email communication program to delete the Email

communication," is not found in the specification.

*Claim Rejections - 35 USC § 103*

16.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains.  Patentability shall not be negatived by the
> manner in which the invention was made.

17.    Claims 30, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Dillon (6067561) in view of Aronson et al. (6654787) (hereinafter Aronson).

18.    Referencing claim 30, as closely interpreted by the Examiner, Dillon teaches a

computer-implemented method for one of a plurality of designated recipients of an Email

communication to receive the Email, comprising:

19.    receiving on a recipient's computer an Email communication notification from the server that references the single copy of the Email communication, the Email communication notification distinct from the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65);

20.    requesting from the server the referenced Email communication, the request being sent to the Email communication program from the recipient's computer system, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65), but does not specifically teach providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients;

21.    receiving by the recipient's computer system from the server, a copy of the requested Email communication.

22.    Aronson teaches providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients, (e.g. col. 10, line 65 – col. 11, line 6);

23.    receiving by the recipient's computer system from the server, a copy of the requested Email communication, (e.g. col. 8, line 30 – col. 9, line 16). It would have been obvious to one skilled in the art at the time the invention was made to combine Aronson with Dillon because it would be more efficient to conserve space with having one central location, having users reference the single copy of the email then having multiple copies of an email taking up substantial space. Furthermore, it is more convenient for a user to have a local copy of an Email

so incase the user is off line and wants to modify the local copy of the Email, the user could with

out modifying the original Email that could be used as an archived document for reference if

desired.


24.     As per claim 34, as closely interpreted by the Examiner, Dillon teaches the Email

communication received from the server is encrypted using a public encryption key for the one

of the plurality of designated recipients, and including retrieving a private encryption key for the

one of the plurality of designated recipients to decrypt the Email communication, (e.g. col. 9, line

60 – col. 10, line 15).


25.     As per claim 35, as closely interpreted by the Examiner, Dillon and Aronson teach all

that is similar in nature to claims 30 and 34, more specifically, Dillon teaches the acts of

receiving the notification, requesting the Email communication and receiving the Email

communication are performed by a receiving computer lacking sufficient permanent storage to

store the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65).


26.     Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561)

in view of Aronson (6654787) in further view of Arnold (6275848).


27.     Referencing claim 31, as closely interpreted by the Examiner, Dillon and Aronson do not

specifically teach when access to the Email communication is no longer desired by the recipient,

indicating to the Email communication program to delete the Email communication, so that the

Email communication program deletes the single stored copy of the Email communication from

the server after receiving indications from all recipients to delete the Email communication.

Arnold teaches when access to the Email communication is no longer desired by the recipient,

indicating to the Email communication program to delete the Email communication, so that the

Email communication program deletes the single stored copy of the Email communication from

the server after receiving indications from all recipients to delete the Email communication, (e.g.

col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time

the invention was made to combine Arnold with the combine system of Dillon and Aronson

because of similar reasons stated above.

28.    Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561)

in view of Aronson (6654787) in further view of Arnold (6275848) with what is well know in

the art.

29.    As per claim 33, Dillon does not specifically teach storing the Email communication

locally by the recipient on the recipients computer system such that the local stored Email

communication is preserved even when the Email communication program deletes the single

stored copy of the Email communication from the server.

30.    Official Notice is taken that it was a common practice to store the Email communication

locally by the recipient on the recipients computer system such that the local stored Email

communication is preserved even when the Email communication program deletes the single

stored copy of the Email communication from the server at the time the instant invention was made.

31.    It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Dillon because of similar reasons stated above. Furthermore, if the user saves the Email locally on one computer and disconnects from the network and then logs in on a different computer and deletes the Email on the server there is no way for the Email to be deleted on the first computer. Also if the user were to save the Email on a floppy disk and then delete the Email form the server, the server cannot delete the Email on the floppy disk, especially if the floppy disk is removed.

32.    Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Arnold (6275848) in further view of Devine et al. (6385644) (hereinafter Devine).

33.    As per claim 32, as closely interpreted by the Examiner, Dillon, Aronson and Arnold do not specifically teach after the receiving of the Email communication notification, storing the Email communication notification locally on the recipients computer system;

34.    after the indicating to the Email communication program to delete the Email communication, deleting the stored Email communication notification by the Email communication program, even if all recipients have not indicated to the Email communication program to delete the Email communication. Devine teaches after the receiving of the Email

communication notification, storing the Email communication notification locally on the

recipients computer system, (e.g. col. 12, lines 40 – 55);

35.     after the indicating to the Email communication program to delete the Email

communication, deleting the stored Email communication notification by the Email

communication program, even if all recipients have not indicated to the Email communication

program to delete the Email communication, (e.g. col. 12, lines 40 – 55). It would have been

obvious to one skilled in the art at the time the invention was made to combine Devine with the

combine system of Dillon, Aronson and Arnold because of similar reasons stated above and

further, if a user has a personal records of Email communication notifications it could prevent

loss of information if the server were to break down and/or crash, (i.e. redundancy).


36.     Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561)

in view of Aronson (6654787) in further view of Homan et al. (6317485).


37.     Referencing claim 36, as closely interpreted by the Examiner, Dillon and Aronson do not

specifically teach wherein contents of the received Email communication notification are based

on preferences for the one of the plurality of designated recipients, the preferences previously

supplied to the server configured with the Email communication program. Homan teaches

wherein contents of the received Email communication notification are based on preferences for

the one of the plurality of designated recipients, the preferences previously supplied to the server

configured with the Email communication program, (e.g. col. 6, lines 28 – 49 & col. 7, lines 1 –

44). It would have been obvious to one skilled in the art at the time the invention was made to

combine Homan with the combine system of Dillon and Aronson because of similar reasons

stated above and further it would be more efficient for a system to utilize a type of preference

setting to classify or possibly utilize different types of Email communication notifications. This

will diversify the way a user may receive notifications about incoming Email.

### *Conclusion*

38.     Applicant's arguments with respect to claims 30 – 36 have been considered but are moot

in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David E. England whose telephone number is 703-305-5333.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

De

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